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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,573	09/19/2003	Michael John Sinclair	A01560 AECM/sd	8616
21898	7590	09/09/2005	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,573

Applicant(s)

SINCLAIR ET AL.

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-6 and 8-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-2-2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Election/Restrictions

Amended claims 14-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims as amended are directed coating compositions, i.e., powder coating compositions, which are structurally different from the originally presented coating compositions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The inventions are distinct, each from the other because of the following reasons:

Inventions of originally presented claims and claims 14-18 as amended are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation and the powder coating compositions obtained by the claimed process are structurally different from the coating compositions as originally claimed and as claimed in claims 1-6 and 8-13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-283621 to Hoechst AG, (hereinafter "Hoechst") in combination with either one of BASF technical Information Sheets for Leporal A 81 or Leporal A 101 of record (hereinafter "Leporal '81 or 101").

The Hoechst reference discloses coating compositions comprising a thermosetting epoxy binder (see [0013-0018]), a curing agent for the thermosetting binder, which can be a phenolic curing agent (see [0020-21]), and polyphosphate compound which decomposes under heat to produce phosphoric acid, i.e., ammonium polyphosphate, (see abstract). The respective amounts of the three components fully correspond to the claimed amounts (see, for example, abstract). The reference further expressly discloses addition of various additives, including viscosity modifiers, or diluents, colouring agents, such as metal oxides and fillers such as china clay. See [0023-0026].

The difference between the invention disclosed in Hoechst reference and the instantly claimed invention is that the claimed coating compositions contains a thermoplastic binder that is an oxygenated heterocyclic thermoplastic resin. Such resins are known in the art, as for example per disclosure of Leparol '81 or 101 tech. Sheets and are useful in epoxy coating compositions for various purposes such as to

Art Unit: 1711

improve gloss, hardness, adhesion and yellowing, resistance., etc. See the Leparol references. Therefore, adding the claimed thermoplastic binder to the compositions disclosed by Hoechst, which are based on epoxy resins, in order to improve the resulting coating properties as per disclosure of Leparol would have been obvious with reasonable expectation of adequate results, absent showing of unexpected results that can be attributed to the addition of such thermoplastic binders. So far the record is devoid of any showing of unexpected results.

The invention as claimed, thus would have been obvious over the combination of the above cited references.

Response to Arguments

Applicant's arguments with respect to claims 1-6 and 8-18 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

The information disclosure statement filed February 2, 2005 has insufficient certification. The certification states that "[T]he additional references were not cited in such a communication and were not known to any individual having a duty of disclosure more than 3 months prior to the filing of this statement." See page 2 of the IDS. However, it appears that one of the patents cited in the IDS was examined by the attorney now prosecuting the instant application and signing the IDS, i.e., Mr. Merriam. Thus, it appears on its face that the attorney was aware of at least one reference more

Art Unit: 1711

that 3 months prior to filing the instant IDS. Thus, a fee set forth in 37 CFR 1.17(p) has been charged to consider the IDS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel
Examiner
Art Unit 1711



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